IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 1627	36th Floor
Examiner	: T. Prasthofer	1600 Market Street
Serial No.	: 09/586,131	Philadelphia, PA 19103
Filed	: June 2, 2000	
Inventors	: Marc Delcourt	Docket: 1184-00
Title	: CLONING METHOD BY MULTIPLE-DIGESTION, VECTORS FOR IMPLEMENTING SAME AND APPLICATIONS	
		Dated: April 9, 2001

RESPONSE

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is submitted in response to the March 9, 2001 Official Action, which is a Restriction Requirement.

We hereby elect, with traverse, Group II including Claims 16, 17 and 19 for immediate prosecution.

We traverse the restriction as it applies to Groups I, II and III. We do not traverse the restriction as it applies to Group IV. Accordingly, we respectfully submit that Groups I, II and III should be examined at the same time.

The basis for the traverse is twofold. First, we note that the Examiner frankly acknowledges that the process for all three of Groups I, II and III is classified in Class 435, Subclass 6. In other words, all three groups may be found in exactly the same subclass. Also, we note that Claim 19 is common to all three groups.

The second basis may be found in MPEP §803 in the opening section. We enclose a computer print-out of the relevant portion of the MPEP for the Examiner's convenience. §803 specifically recites that there are two criteria for proper requirement for restriction between patentably distinct inventions, namely a) the inventions must be independent or

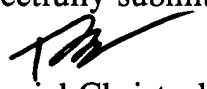
distinct as claimed and b) there must be a serious burden on the Examiner if restriction is required. We note that both (a) and (b) must be present.

In this case, we respectfully submit that the second criteria, namely that there must be a serious burden on the Examiner if restriction is required, is not present in this case. By the Examiner's acknowledgment, the invention can be searched and considered by reference to a common class and a common subclass. Accordingly, it would inherently follow that relevant prior art, if any, would be found for all three groups in the same classes and subclasses. We, therefore, respectfully submit that not only is there not a serious burden on the Examiner, but that there is no burden at all.

In view of the fact that the second prong of the criteria for proper requirement for restriction has not been met, Groups I, II and III should be considered together and the restriction should only, at best, be maintained with respect to Group IV.

In light of the foregoing, we respectfully request substantive examination of Claims 1 - 19 at this time. Withdrawal of the Restriction Requirement as it applies to Groups I, II and III is accordingly respectfully requested.

Respectfully submitted,



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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Certificate of Mailing Under 37 CFR 1.8

For

Postcard
Response
MPEP Print-out

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, DC 20231, on the date appearing below.

Name of Applicant, Assignee, Applicant's Attorney
or Registered Representative:

Schnader Harrison Segal & Lewis LLP
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1600 Market Street
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By: _____

Date: 9 APR 2001

Previous: 802.02 Definition of Restriction
Next: 803.01 Review by Examiner With at Least Partial Signatory.
Up: Chapter 08 Table of Contents.
Search

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP Section 806.04 - Section 806.04(i)) or distinct (MPEP Section 806.05 - Section 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01 Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02 Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. In re Lee, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP Section 808.02 . That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP Section 803.02 . Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP Section 806.04(a)(a) - Section 806.04(i) and Section 808.01(a).

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